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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,022	10/20/2003	Frank Hallock Ebetino	9071M	4104

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
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CINCINNATI, OH 45224

EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,022

Applicant(s)

EBETINO ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-10,12,14,16,18-22,28,29 and 32, drawn to piperazine compounds, compositions of Formula i) and ii) (see claim 2) where for ii), L=N, classified in class 544, subclasses 384 and many others as determined by the nature of hetero rings attached thereon, eg. subclass 363 when quinolines/isoquinolines are present; class 514 subclass 255.01, etc.
- II. Claims 1-4,16 and 32, drawn to piperazine compounds, compositions of Formula ii) not provided for by I classified in class 544, subclasses such as 386,etc. and class 514 various subclasses.
- III. Claims 1-7,11,13,15-17,20,23-27,30-32, drawn to piperazine compounds, compositions of formula iii) and v) where for v), L=N, classified in class 544, subclass 391 and many others; class 514 subclass 255.01,etc.
- IV. Claims 1-4,16 and 32, drawn to other piperazines not provided for by I-III, classified in class 544, subclasses various based on the very least by the exact nature "L" link directly attached to the ring; class 514, various subclasses.

- V. Claims 1-7,16 and 32, drawn to pyrrolidine compounds, compositions of formula iv), classified in class 548, subclass 540 and other higher-ranking classes when hetero rings are attached thereon; class 514 subclass 423, etc.
- VI. Claims 1,16 and 32, drawn to other pyrrolidine compounds, compositions not provided for by V, classified in class 548 and other classes, subclasses various; class 514, various subclasses.
- VII. Claims 1-7,16 and 32, drawn to piperidine compounds, compositions of formula vi) and vii) where for vii), $L=N$, classified in class 546, subclasses such as 195,205,226,etc; class 514 subclasses such as 319,330.
- VIII. Claims 1-4,16 and 32, drawn to other piperidine compounds, compositions not provided for by VII, classified in class 546, subclasses various; class 514, various subclasses.
- IX. Claims 1-7,16 and 32, drawn to diazepine compounds, compositions of formula viii), classified in class 540, subclass 575; class 514 subclass 218.

- X. Claims 1,16 and 32, drawn to other diazepine compounds not provided for by IX, classified in class 540, subclass 575; class 514 subclass 218.
- XI. Claims 1,16 and 32, drawn to other A-containing cores (eg. reduced forms of triazines, pyrimidines, imidazoline, azocines) not provided for by I-X, classified in classes 540-548, subclasses various and class 514, various subclasses.
- XII. Claims 33-38, drawn to multiple uses employing compounds of I-XI, classified in class 514, subclasses various as based on the structural makeup of compounds employed.

In addition to an election of any of the above groups, further election of a single species is required. In view of the many permutations present at R and W, and elsewhere, based on species elected, further restriction will be made by the examiner at R between:

- A. choices a) and b);
- B. choices c) and d).

If groups II,IV, VI,VIII,X or XI is elected further restriction will be required at "L" directly connected to the A ring as well as single core if XI is elected.

If group XII is elected applicants must a single use and a compound group with further restriction as indicated above.

The inventions are distinct, each from the other because of the following reasons:

Compounds within groups I-XII relate to compounds of considerable structural dissimilarity in view of the varying central core as well as multitude of choices permitted on the central ring. Thus they are separately and variously classified.

While some groups may share a common classification they may require separate , additional subclasses be searched based on the presence of additional hetero rings, ring systems as described in the specification . Also the nature of "L" directly connected to the ring will affect classification. Further exacerbating the search for the entire set of claims is the need for separate electronic searches given the multitude of compounds expected to be generated for the basic cores which do not further require a fixed mandatory substituent thereon. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group and are not art-recognized equivalents.

Inventions I-XII and XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be

shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case a variety of uses are urged for the compounds of the invention which may raise separate issues from just an examination of the compound/composition claims.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction

requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Emily Bernhardt
Primary Examiner
Art Unit 1624